

REMARKS

At the time of the Office Action dated August 23, 2005, claims 1-34 were pending and rejected in this application. Claims 11-12, 21-22, and 33-34 have been amended, and Applicant submits that the present Amendment does not generate any new matter issue.

CLAIMS 11-12, 21-22, AND 33-34 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

In the seventh enumerated paragraph of the Office Action, the Examiner asserted that the use of the term "Java" rendered the rejected claims indefinite. This rejection is respectfully traversed.

Applicant notes that claims 11-12, 21-22, and 33-34 have been amended to remove all references to the term "Java" in the claims. Applicant, therefore, respectfully solicits withdrawal of the imposed rejection of claims 11-12, 21-22, and 33-34 under the second paragraph of 35 U.S.C. § 112.

CLAIMS 1-22 ARE REJECTED UNDER 35 U.S.C. § 101

In the ninth enumerated paragraph of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-22, is directed to non-statutory subject matter. This rejection is respectfully traversed.

35 U.S.C. § 101 states the following:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-12 are directed to a method and claims 13-22 are directed to an apparatus, both of which fall within the statutory subjected matter defined by 35 U.S.C. § 101. Applicant notes that a precedential opinion¹ has been issued by the Board of Patent Appeals and Interferences (hereinafter the Board) subsequent to the issuance of the present Office Action, addressing issues associated with 35 U.S.C. § 101. Applicant submits that the Examiner's test regarding subject matter that "is not of a concrete and tangible nature" is not consistent with the decision issued by the Board in Ex parte Lundgren. Applicant, therefore, respectfully solicits withdrawal of the imposed rejection of claims 1-22 under 35 U.S.C. § 101.

CLAIMS 1-6, 9, 11-17, 20-28, AND 31-34 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY BAHLS ET AL., U.S. PATENT NO. 5,706,513 (HEREINAFTER BAHLS)

On page two of the Office Action, the Examiner asserted that Bahls discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

¹ Ex parte Lundgren, Appeal No. 2003-2088.

Claims 1, 13, and 23

Independent claims 1, 13, and 23 each recite an entity "in the form of a key or certificate" and that the entity is fragmented into fragments of non-uniform length. In the statement of the rejection the Examiner referred to Fig. 7; column 3, lines 41-60; column 5, lines 33-67; and column 6, lines 1-3 of Bahls to teach these limitations. As described in column 5, lines 55-62, the data object Obj 1 is divided into N segments, and referring to Fig. 7 of Bahls, each queue record 402, 502, 602, 702, 704, 706, 708 includes: (i) the divided segment of the object and (ii) a key. Thus, Bahls distinguishes between the data object Obj 1 and a key.

The Examiner, however, has failed to disclose where Bahls teaches that the key is fragmented, as recited in the claims. Therefore, whereas the claimed invention recites that an entity (e.g., in the form of a key) is fragmented, Bahls discloses that the data object Obj 1 is segmented, which fails to identically disclose the claimed invention, as recited in claims 1, 13, and 23, within the meaning of 35 U.S.C. 102.

Claims 3, 15, and 25

Claims 3, 15, and 25 each recite that "the storage means also contains random bit patterns (120)." In the statement of the rejection, the Examiner asserted that "[n]ulls as defined relate to material of no consequence, effect, or value, as such these nulls may be of any nature such as that of random bit patterns since a random bit pattern follows the same as being of no consequence, effect, or value." Applicant respectfully disagrees.

Column 5, lines 66-67 of Bahls states "the Nth segment may be padded with nulls to make its size equal to segment size." As the term "nulls" is commonly used in this context, a series of bit, each bit having the value of "0," would likely be added to the Nth segment. It is also conceivable that each bit could have the value of "1." However, in each instance the series of bits added to the Nth segment would not be random (i.e., without a discernible pattern).

The Examiner's statement that a random bit pattern is the same as nulls "since a random bit pattern ... as being of no consequence, effect, or value" is in direct contrast to Applicant's disclosure. As discussed in the paragraph spanning pages 2-3 of Applicant's disclosure, "the keys to the cryptographic systems are unusual numbers with specific mathematical properties that make it possible for an attacker to identify them within the file store." However, as discussed in the paragraph spanning pages 6-7, "[r]andom bit patterns can also be added to the file to make key identification more difficult." Thus, the claimed random bit pattern does have a consequence/effect/value, which is to make the identification of the key more difficult. Therefore, for the reasons stated above, Bahls fails to identically disclose the claimed invention, as recited in claims 3, 15, and 25, within the meaning of 35 U.S.C. 102.

Claims 5, 16, and 27

Claims 5, 16, and 27 each recite that "the location of storing the fragments (152, 154) is also determined by the algorithm (200)" (emphasis added). By using the term "the," these claims refer back to the first instance of the term "algorithm." Thus, the algorithm recited in claims 5,

16, and 27 that determines the location of storing the fragments is also the same algorithm that determines how the entity is to be fragmented into fragments.

In the statement of the rejection, the Examiner asserted that "[a]ny implementation that resolves such an issue must then logically be composed of an algorithm," apparently intending to assert that since the segments of the object are stored, the determination of where these segments are to be stored are a result of an algorithm. This analysis, however, fails to account for the claimed limitation that the algorithm for determining the location where the fragments are to be stored is also the same algorithm that determines how the entity is to be fragmented into fragments. The algorithm (see column 5, line 59) disclosed by Bahls does not appear to determine where the fragments are stored. Therefore, Bahls fails to identically disclose the claimed invention, as recited in claims 1, 13, and 23, within the meaning of 35 U.S.C. 102. Thus, Applicant respectfully solicits withdrawal of the imposed rejection of claims 1-6, 9, 11-17, 20-28, and 31-34 under 35 U.S.C. 102 for anticipation based upon Bahls.

**CLAIMS 7-8, 18-19, AND 29-30 ARE REJECTED UNDER 35 U.S.C. § 103 FOR
OBVIOUSNESS BASED UPON BAHLS IN VIEW OF STEIN, U.S. PATENT NO. 6,370,250**

On pages 7-8 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Bahls in view of Stein to arrive at the claimed invention. This rejection is respectfully traversed.

Although Applicant disagrees that the claimed invention is obvious based upon Bahls in view of Stein, to expedite prosecution of the Application, Applicant submit that the reference to Stein cannot be properly applied against the present Application under 35 U.S.C. § 103. As discussed in M.P.E.P. § 2146, a reference that qualifies as "prior art" only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the prior art and the claimed invention were commonly owned at the time of the invention. See M.P.E.P. § 706.02(I).

**Application No. 10/046,058 (the present application) and
U.S. Patent No. 6,370,250 (Stein) were, at the time the invention
was made, commonly owned by International Business Machines
Corporation**

Thus, under 35 U.S.C. § 103(c), the reference to Stein cannot be considered by the Examiner when determining whether Applicant's invention is obvious under 35 U.S.C. § 103. Applicant, therefore, respectfully submit that the imposed rejection of claims 7-8, 18-19, and 29-30 under 35 U.S.C. § 103 for obviousness based upon the Bahls in view of Stein is not viable and, hence, solicits withdrawal thereof.

CLAIM 10 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON BAHLS

On page 8 of the Office Action, the Examiner concluded that it is well known in the that "when a collision occurs the object is stored immediately following the occupied spot."

Notwithstanding what was known or not known by one having ordinary skill in the art, the Examiner has failed to establish a prima facie case of obviousness. The Examiner has employed an "obvious to try" argument (i.e., it would have been obvious to modify Bahls since the limitation was known in the art), which is not proper. Rather, a burden is imposed upon the Examiner to identify a source in the applied prior art for each claim limitation and identify a source for the requisite realistic motivation to modify a particular reference in a particular manner to arrive at a specifically claimed invention.² Applicant, therefore, respectfully submit that the imposed rejection of claim 10 under 35 U.S.C. § 103 for obviousness based upon the Bahls is not viable and, hence, solicits withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

² Smiths Industries Medical System v. Vital Signs Inc., 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999); In re Mayne, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997).

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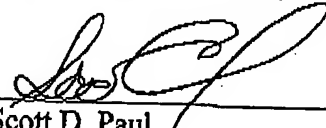
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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,



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